REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-10, 12-16, 18, 20, and 21 are pending in the present application.

In the outstanding Office Action, the drawings were objected to for presenting new matter; the specification was object to under 35 U.S.C. §112, first paragraph, for failing to support the subject matter set forth in Claims 1-21; Claims 1-21 were rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in the objection to the specification; Claims 1, 2, 4, 8-10, 12-14, 18, 20, and 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Babu et al. (U.S. Patent No. 6,122,639, hereinafter Babu) in view of Mauger et al. (U.S. Patent No. 6,937,612, hereinafter Mauger); Claims 3 and 16 were rejected under 35 U.S.C. §103(a) as obvious over Babu in view Mauger, and further in view of Koo (U.S. Patent Publication No. 2001/0032270); and Claims 5-7 and 15 were rejected under 35 U.S.C. §103(a) as obvious over Babu in view of Mauger, and further in view of Buhrke et al. (U.S. Patent No. 5,231,631, hereinafter Buhrke).

Applicant thanks Examiner Divechia, Primary Examiner Dinh, and Supervisory Patent Examiner Maung for the interview in which the above-noted rejections regarding the addition of new matter were discussed. It was agreed that no new matter was added in the previously filed amendments. Further, it was agreed that the objection to the drawings, the objection to the specification, and the rejection of Claim 1-21 under 35 U.S.C. §112, first paragraph, would be withdrawn.

Thus, Applicant considers the objection to the drawings, the objection to the specification, and the rejection of Claims 1-21 under 35 U.S.C. §112, first paragraph, to be moot.

With respect to the rejection of Claim 1 as unpatentable over <u>Babu</u> and <u>Mauger</u>, Applicant respectfully traverses the rejection. Claim 1 recites, *inter alia*, "classify a functionality of the at least one network device via the one network communication port based upon network transmission characteristics of the at least one network device and the determined software application."

In the claimed invention, functionality is classified based on two criteria: (1) transmission characteristics of the network device, and (2) the software application determined to be running on the device. Neither <u>Babu</u> nor <u>Mauger</u> disclose or suggest classifying functionality based on both of these characteristics, as explained below.

The outstanding Office Action states "Babu does not disclose the process of classify a functionality of at least one network device via the one network communication port **based upon network transmission characteristics of the at least one network device**" (emphasis in original).[1]

It appears that patentable weight has not been given to the limitation "and the determined software" because, in the Examiner's view, Applicant failed to show or prove that the specification discloses the process of classifying a functionality of the at least one network device...based upon the determined software application.[2] In light of the above-noted telephone discussion, Applicants consider this point to be moot.

Furthermore, Applicants note that MPEP §2163.06 states that even if a new matter rejection is made, "[t]he examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by the applicant." Accordingly, Applicant considers the outstanding rejection to be deficient, and respectfully requests that a new rejection on the merits be issued that fully considers all the claim limitations.

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[1] Office Action, page 10.
[2] Office Action, page 4.

3

Furthermore, the outstanding Office Action fails set forth grounds as to why either Babu or Mauger disclose classifying a functionality of the at least one network device…based upon the determined software application.

Babu does not disclose the claimed "classify a functionality of the at least one network device via the one network communication port based upon network transmission characteristics of the at least one network device **and** the determined software application." Assuming, *arguendo*, that the outstanding Office Action is correct that an SNMP query reveals the software running on the queried device, there is no disclosure or suggestion that functionality of the queried device is classified based on the software running on it. Babu discloses that basic device data is supplied in response to the SNMP query, that the basic device data includes device name and a device type code that identifies the specific type of device that has responded.[3] With this specific information about the device, the system of Babu does not need to classify device functionality based on the type of software running on the device.

Furthermore, Mauger does not cure the above-noted deficiency of Babu. Particularly, Mauger does not disclose or suggest "classify a functionality of the at least one network device via the one network communication port based upon…the determined software application." Applicants note that page 13 of the Office Action mailed August 26, 2005 states that Mauger does not disclose the process of determining software applications running on network devices.

It is noted that the outstanding Office Action relies on the claims of Mauger. The rejection of the present Application, based on reference to a patent claim is clearly improper. The Federal Circuit has characterized analysis of prior art patent claims with respect to the

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[3] Babu, col. 8, lines 1-6.

4

patentability of an Application as "a plainly indefensible line of reasoning" (*In Re* <u>Benno</u>,

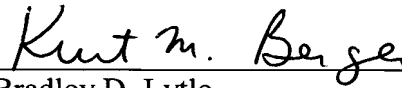226 U.S.P.Q. 683, 686, Fed. Cir. 1985) and further stated that:

> The scope of a patent's claim determines what infringes the patent;
> <u>it is no measure of what it discloses</u>. A patent discloses only that which it
> describes, whether specifically, or in general terms, so as to convey
> intelligence to one capable of understanding (*See* <u>Benno</u> at 686) (emphasis
> added)).

In view of the above-noted distinctions, Applicant respectfully submits that Claim 1 (and

dependent Claims 2-10, and 12) patentably distinguishes over <u>Babu</u> and <u>Mauger</u>, taken alone

or in proper combination. In addition, Applicants respectfully submit that independent

Claims 13, 18, and 21 (and Claims 14-16, and 20 dependent thereon) patentably distinguish

over <u>Babu</u> and <u>Mauger</u>, taken alone or in proper combination, for at least the reasons stated

for amended Claim 1.

Consequently, in light of the above discussion, the present application is believed to

be in condition for allowance and an early and favorable action to that effect is respectfully

requested.

Respectfully submitted,

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